

Appl. No. 10/808,697  
Reply to Office Action of 5/24/2005

Attorney Docket No. WS-106

### **REMARKS/ARGUMENTS**

Claims 1 and 22 were amended. Claims 2-5, 8-21, 23-31, 34-36, and 38-44 remain unchanged. Claims 6, 7, 32, 33, and 37 were previously canceled.

Claims 1 and 22 were amended to include the recitation that the smart card reader/writer comprises means for receiving a voucher smart card, means for storing information onto the voucher smart card and means for reading information from the voucher smart card. As recited in claim 3 the voucher smart card may be a "full size" smart credit card, a "full size" smart debit card, a "plug-in" Subscriber Identification Module (SIM) smart card, a "plug-in" Secure Access Module (SAM) smart card, a contactless smart card, a stored-value card, a coupon card, a reward card, an electronic cash card, a loyalty card, an identification card and combinations thereof.

The Examiner correctly acknowledged that Nakamura does not disclose the card reader/writer is connected to the mobile communication device via a SIM card slot in the mobile communication device and withdrew the previous rejection of claims 1-5, 8-31, 34-36, and 38-44 under 35 USC 103(a). However, instead of allowing claims 1-5, 8-31, 34-36, and 38-44, the Examiner proceeded with another prior art search and presented new grounds of rejection made under 35 USC 103(a) over Nakamura in view of Takemura (US Patent 5,923,082) and Phillips (US Patent 6,240,301). We would like to point out that the Applicant did not present any claim amendments that would have caused the Examiner to proceed with this additional prior art search.

Referring to FIG. 1, of US 5,923,082, Takemura discloses "a computer device 1 functioning as an information processing device, such as a notebook-type personal computer. The computer device 1 includes: a front portion having an insertion slot 1a for allowing a card-type device (i.e., IC card reading/writing device 3) to be inserted into the computer device 1;" (column 3, lines 56-61). "The IC card reading/writing device 3 has a light emitting diode (LED) 12, an eject button 13, and a connector portion 10 to be electrically connected to the connector 2a of the computer device 1." (column 3, line 66

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to column 4 line 2). In other words, Takemura refers to an insertion slot 1a that receives the entire card-type device and the device is actually connected to the computer device via a connector 2a and not via a SIM slot, i.e., a slot that is designed to receive SIM cards, as is the case in the present invention. The Examiner correctly acknowledges that the insertion slot 1a in Takemura's computer device is different from a SIM slot and there is no suggestion by Takemura that the insertion slot 1a can be used for receiving a SIM card. We would also like to point out that a typical card-type device has dimensions of 85X54X3 millimeters, whereas a typical SIM card and the corresponding SIM slot that receives the SIM card have dimensions of 18X10X0.5 millimeters. Accordingly, a typical SIM card slot is dimensionally incompatible for receiving a typical card-type device.

Based on these differences, claims 1-5, 8-31, 34-36, and 38-44 of the present invention are patentably distinguishable from the Takemura patent.

Referring to FIG. 2A of US Patent 6,240,301, Phillips discloses, "Mobile terminal 10' is configured to use under the GSM telephony protocol, and receives SIM module 50' mated thereto. Mobile terminal 10 is configured for use under the PDC telephony protocol, and receives SIM-size module 50, containing a diversity antenna, mated thereto." (column 2, lines 53-58). In other words, the SIM module 50' is replaced with the diversity antenna module 50 in order to switch from the GSM communication protocol to the PDC communication protocol. The dimensions of the diversity antenna module are no larger than the dimensions of the SIM card (column 1, lines 6-9)

We would like to point out the following differences of the present invention from the Phillips patent:

The diversity antenna module 50 of the Phillips patent is a communication module whereas the card reader/writer module of the present invention is not a communication module.

The diversity antenna module 50 of the Phillips patent has dimensions similar to a SIM card, which makes the replacement of one module with the other dimensionally

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feasible. Although there are no dimensional limitations for the card reader/writer module of the present invention it may have the above mentioned typical dimensions of a card type device which will make it dimensionally incompatible as a replacement for a SIM card.

There is no suggestion anywhere in the Phillips patent of connecting a card/reader writer to the SIM slot.

If the SIM card was to be replaced with a card reader/writer instead of the diversity antenna in the Phillips invention, the mobile phone 10' would not any more function as a communication device. There is still an inventive step missing that would enable the card reader/writer to connect to the SIM slot while maintaining the ability of the mobile phone 10' to communicate with the network. This inventive step is provided by the present invention. As claimed in claim 1:

"a mobile communication device comprising a subscriber identification module (SIM) card slot and being adapted to connect to said voucher host system via a network connection and to download said prepaid electronic vouchers;

a smart card reader/writer module adapted to electrically connect to said SIM card slot of said mobile communication device"

In other words, the mobile communication device of the present invention has the ability to communicate with the voucher host system via a network connection and has a smart card reader/writer connected to the mobile communication device via the SIM card slot.

On the contrary the mobile terminal 10 of the Phillips invention not only it does not have or suggest the functionality of card reading/writing but also it does not have dual capability even in the single function of communication because it functions either as a GSM phone or as a PDC phone, but not simultaneously both as a GSM phone and a PDC phone.

Based on these differences, the claims 1-5, 8-31, 34-36, and 38-44 of the present invention are patentably distinguishable from the Phillips patent.

The Philips patent addresses the problem of providing a single mechanical housing for a mobile phone that provides wireless communications functionality under different

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standards, i.e., GSM or PDC. The Takemura patent addresses the problem of connecting a card reader device to a portable computer device. The Nakamura patent addresses the problem of providing an electronic ticket management system. There is no motivation or suggestion for combining the Phillips patent with the Takemura patent and then with the Nakamura patent. Even if they were combined by some arbitrary and random reason there would still be missing the above mentioned inventive step of providing a mobile communication device that provides simultaneously communication functionality and card reading/writing functionality by connecting a card reader/writer to the communication device via the SIM slot.

Accordingly, since Nakamura or Takemura, or Phillips neither alone nor in combination suggest a system for generating and storing prepaid electronic vouchers that includes a card reader/writer and a mobile communication device and where the card reader/writer is attached to a SIM card slot of the communication device, the 35 USC 103 rejection of claims 1-5, 8-31, 34-36, and 38-44 over Nakamura in view of Takemura and further in view of Phillips is overcome. This particular configuration has the following two advantages: a) universality in the connectivity of the card reader/writer by connecting it to the SIM card slot, rather than to a parallel or serial port of the communication device; and b) secure authentication through the SIM card module of the communication device.

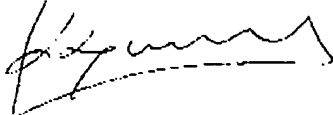
In view of the above, it is submitted that all claims are in condition for allowance. Reconsideration of the rejections and objections is requested and allowance of all claims at an early date is solicited.

If this response is found to be incomplete, or if a telephone conference would otherwise be helpful, please call the undersigned at 781-235-4407

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Respectfully submitted,



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I hereby certify under 37 CFR 1.10 that this correspondence is being faxed on the date indicated above and is addressed to the Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450